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REMARKS

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Applicant has carefully considered the Examiner's Office Action and has amended the claims responsively to define the invention in clearer form, and to distinguish patentably from the prior art.

Applicant notes that the Examiner has made the present Office Action a "Final" on the grounds that applicant's previous Amendment made that necessary. However, the previous Amendment had precisely the same subject matter in the claims as previously, and applicant even mentioned that in the "Remarks" of the previous Amendment, because no references were applied at that time, and applicant was thereby under the impression that the application would thereby become allowed.

It is noted also that there was no reason to amend the subject matter of the claims in the previous Amendment, since the Examiner had not applied any prior art against the claims in the first Office Action.

It is surprising, therefore, that a reference has been applied in the present Office Action, since such a reference could have been applied previously.

It is submitted, therefore, that the present Office Action should not be designated "Final." It is respectfully requested therefore, that the finality of the present Office Action be withdrawn.

In response to the Examiner's objections to claims 17, 18 and 19, applicant has amended these claims to avoid the objections under 35 U.S.C. 112.

It is believed that with the present amendments to claims 17-19, the requirements for definiteness are met under 35 U.S.C. 112.

The Examiner has also raised objections against the specification. However, these objections were responded to in the previous Amendment. Applicant is including a duplicate of

page 2 of the previous Amendment which responded to the Examiner's objections to the specification, as noted in the present Office Action. Applicant is submitting this duplicate page 2 of the previous Amendment in the event that this page became lost.

The Examiner has required a new Declaration to be submitted. Applicant will submit such a new Declaration as soon as it is returned signed by the four inventors in this application.

The Examiner has rejected claims 17 and 30-32 provisionally on the grounds of non-statutory obviousness type double patenting as being unpatentable over claims 20-23 of copending U.S. Patent Application 10/551,540.

In response thereto, applicant notes that the independent claim in Patent Application 10/551,540 (claim 24) recites a concrete construction for the forced guidance of the intermediate member. The independent claims in that application relate to the manner in which the displacement of the intermediate member follows on the displacement curve.

Thus, claim 17 of the present application provides that the angular sensors for sensing angular signals of the crankshaft and the cam shaft or one or the other with run at half the crankshaft speed, from which the common resting phase of all common valves to be displaced of a cylinder can be realized. Such technical teachings are not disclosed in the claims of the Patent Application 10/551,540, and such claims are not present in that Application 10/551,540.

It is submitted, therefore, that double patenting does not prevail between the present application and the Application 10/551,540.

Applicant notes, furthermore, that the present application and 10/551,540 stem from PCT applications, and these two applications were filed the very same day, and both of these applications have the same international application date of

March 17, 2004. For that reason, a citation of double patenting does not apply.

The Examiner has rejected claims 18-21 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

In response thereto, applicant notes that the person skilled in the art relevant to the present application, is an experienced engineer who has a background in the construction of numerous mechanical valve drives. Such a professional person understands what is meant by what the Examiner has noted in the first three lines of the present Office Action on page 4. For example, in the last paragraph of the description applicable to Figure 6 of the present application, there is described that the sector R of the cam disk 47 is constructed as a concentric arc 49 through a rotational center 48 of the displacement shaft 45. The professional person in the art understands that due to the construction of the arc 49 concentric with the center of rotation, no displacement motion is transmitted to the displaceable operating member, through a rotation of the cam disk 47.

First when a section of the cam disk has an effect of the displacing drive, which deviates from the concentric arc 49, is a displacement motion transmitted. This is described also clearly in the last paragraph of the description of Figure 6 in the present application. It is described there, "such a design of cam disks 46 and 47 has the result that when adjusting shaft 45 is rotated about its center of rotation 48, the displacement units for the valves of cylinders 1, 4, and 5 are further displaced in the active area of sector R, while the displacement units for the valves of cylinders 2, 3, and 6 remain at rest."

Accordingly, the cam disk 47 is that cam disk arranged in cylinders 2, 3, and 6. Through this description of Figure 6, the professional person in the art attains the teachings that the arc 49 constructed concentric to the center of rotation 48,

is on the cam disk 47, and no displacement motion is transmitted to the displacement units for the valves of the cylinder 2, 3, and 6. The professional person skilled in the art, therefore, knows that when the section 49 in claim 18 is constructed as an arc, it is concentric to the rotational center 48 of the displacement shaft 45.

From the preceding background the technical teachings of the claims are fully understandable and provide an enabling disclosure.

With respect to the Examiner's rejection of claims 18-21 under 35 U.S.C. 112, second paragraph, the amended claims provide the necessary antecedent basis to render the claims definite under 35 U.S.C. 112.

The Examiner has rejected claims 17, and 22-29 under 35 U.S.C. 102(a) or 35 U.S.C. 103(a) over the reference patent to Allgeier et al. (WO '972). However, the Examiner does not relate this reference to the features and aspects of applicant's claim 17, nor the dependent claims 22-29 that are dependent on claim 17. However, in the preliminary part of claim 17, applicant recites those aspects of the reference WO '972 as part of the prior art, as also listed in the Examiner's Office Action on page 5.

Applicant proceeds, however, from such listing of prior art in claim 17, with the additional elements and features that are not disclosed in this reference WO '972. Thus, applicant's claim 17 recites the invention which extends and proceeds from what is disclosed in this reference. This reference, therefore, has no material bearing on applicant's claim 17.

Proceeding from the prior art, applicant's invention provides the technical teachings that the displacement for gas exchange valves of a cylinder in a displacement unit is independent of the displacement of displacement units of other cylinders. Thereby each displacement unit has separate actuators. Claim 17 provides, furthermore, that angular sensors

for sensing angular signals of the crankshaft and the cam shaft or another with half crankshaft rotational speed can be obtained for the common rest phase of all common adjustable valves of a cylinder. Such a sensing of angular signals of the crankshaft with angular sensors is not disclosed in the reference to Allgeier, and the Examiner has also not asserted that these features are disclosed there. The Examiner has, instead, not considered the novel aspects of applicant's invention.

Applicant's claim 17 provides, furthermore, the teachings of applying a control unit 44 which functions for the displacement of each displacement unit essentially during the common resting phase of all common valves to be displaced in a cylinder. The Examiner has also not considered this essential novel feature in his decision in the Office Action. This feature is also not disclosed in the reference patent to Allgeier.

Accordingly, applicant provides for a new and marked improvement over the prior art. The prior art does not anticipate the elements and features of applicant's claim 17. For this reason, claim 17 and the remaining other claims in the application should be found allowable.

The Examiner's attention is respectfully directed to the Court decision in the case of United Merchants and Manufacturers Incorporated versus Ladd (139 U.S.P.Q. 199). In that decision, the District Court ruled that although from simplicity of device and with advantage of hindsight, one might offhandedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the reference discloses or suggests the concept which is the crux of the invention.

Furthermore, in the case of Ex parte Fleischmann (157 U.S.P.Q. 155), the Patent Office Board of Appeals ruled that while it might be possible to select features from secondary references and mechanically combine them with primary reference

to arrive at applicant's claim combination, there is no basis for making such combination disclosed or suggested in references; only applicant's specification suggests any reasons for combining references; under 35 U.S.C. 103, that does not constitute a bar.

In the case of Panduit Corporation v. Burndy Corporation (180 U.S.P.Q. 498), the District court ruled that inquiry into patentability must be directed towards subject matter as a whole and not to elements of combination and their individual novelty; combination which results in a more facile, economical, or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that elements are individually old.

In the case of Bisley (94 U.S.P.Q. 80; 86), the Court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

In the case of ex parte Chicago Rawhide Manufacturing Company (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of

appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of The Standard Oil Company vs. American Cyanamid Company (227 U.S.P.Q. 293), the court ruled that the issue of obviousness is determined entirely with reference to a hypothetical person having ordinary skill in the art. It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventor's, as a class, according to the concepts underlying the constitution and the statutes that have created the patent system, possess something that sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under 35 U.S.C. 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive systematic research or by extraordinary insight; it makes no difference which.

In the case of Uniroyal Inc. versus Rudkin-Wiley Corporation (5 U.S.P.Q.2d 1434), the Court decided that when prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness of making the combination.

The preceding decision is reinforced by the case *In re Dow Chemical Company* (5 U.S.P.Q.2d 1529), in which the Court decided that most technological advance is the fruit of methodical persistent investigation, as is recognized in 35 U.S.C. §103. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

Finally, in the case of *Meng and Driessen* (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the amendments to the claims, and in view of the preceding remarks, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

Should the Examiner consider it advisable or require that the specification and/or claims be further amended or corrected in formal respects to place the application in condition for final allowance, then it is respectfully requested that such amendments be carried out by Examiner's Amendment, through a phone call to applicant's representative, and the case passed to issue.

Respectfully submitted,

This amendment is being
transmitted by fax on
August 13, 2007

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